

REMARKS

This response is provided to the Office Action of January 12th, 2004. With this response, Applicant has amended claims 15 and 18 and has cancelled claim 14 without prejudice. Applicant respectfully submits that the amendment to claim 15 was merely to that of form and, as such, should not be construed as a narrowing amendment. The amendment to claim 18 was merely to clarify inherent limitations already found within the claim and, in this regard, should not be construed as a narrowing amendment (see, e.g., Bose v. JBL, 274 F.3d 1354 (CAFC 2001)). Support for the amendments can be found in the original specification, figures and/or claims and, as such, no new matter has been introduced. Accordingly, with this response, claims 5-7, 11-13 and 15-22 remain pending.

Claim Objections

In **paragraph 1** of the Action, claim 18 was objected to as being unclear. Accordingly, Applicant has amended claim 18, as above, to further clarify the inherent features of such claim. In view of the foregoing amendment, Applicant respectfully requests that the objection to claim 18 be withdrawn.

§102(e) Rejection of Claims 5 and 20

In **paragraphs 2-5** of the Action, claims 5 and 20 were rejected as being anticipated by a patent issued to Greenbaum, et al. (USP 6,077,315) pursuant to 35 USC §102(e). In response, Applicant traverses the rejection of such claims.

It is well settled that in order to support a §102 rejection, the Office must establish that a single, prior art reference teaches each and every element of a claim, as such elements are

presented within the rejected claim. In this case, Applicant respectfully submits that the Office has failed to establish this prima facie basis for the §102 rejection of at least claims 5 and 20.

In particular, Applicant respectfully submits that Greenbaum fails to teach the claimed feature wherein “wherein each configuration is identified by a unique off-chip address used to fetch that configuration”. Recognizing this limitation, the Action provides that “it is well-known that data stored in a cache is identified by the data’s unique address in external memory” (see, e.g., para. 4). In this regard, asserting a §102 rejection against such claim, the Action essentially argues that such feature is *inherent* in the Greenbaum reference. Applicant respectfully disagrees on two counts.

First, for a feature to meet the legal definition of inherency, the feature must be the only way in which to practice the claimed feature – in this case, denoting each configuration by an unique off-chip address. Applicant respectfully submits that denoting each configuration in cache by an unique off-chip address is not the only way in which to identify such configuration, and the Action has failed to provide support to the contrary. Insofar as it is the incumbent to provide such support to maintain a §102 rejection, and that the Action has failed to meet this burden, Applicant respectfully submits that such rejection is improper on at least such basis.

Second, the Action provides that it is well-known that *data* stored in a cache is identified by the *data*’s unique address in external memory. Without acknowledging the accuracy of that assertion, Applicant respectfully submits that the assertion nonetheless fails to teach the claimed feature that provides for identifying each *configuration* by a unique off-chip address used to fetch that configuration. That is, the claimed feature provides for identifying each configuration on a configuration by configuration basis, not on an individual datum by datum basis. In this regard, the Action has failed to provide support to maintain the §102 rejection.

For at least the foregoing reasons, Applicant respectfully submits that the Action has failed to establish a prima facie basis for the §102(e) rejection of at least claims 5 and 20.

Accordingly, Applicant respectfully requests that the rejection of such claims be withdrawn.

§103(a) Rejection of Claims 6 and 11-17

In **paragraphs 6-14**, the Action provides that claims 6 and 11-17 are unpatentable over the Greenbaum reference in further view of a patent issued to Singh et al. (USP 6,324,621) under 35 USC §103(a). In response, Applicant respectfully traverses the basis for such rejection.

Applicant notes that the Singh reference is not cited as curing and does not, in fact, cure the limitations in the Greenbaum reference vis-à-vis rejected claim 5, as provided above.

Accordingly, Applicant respectfully submits that claim 5 is patentable over the combination of such references for at least the distinguishing arguments provided above.

Insofar as claims 6 and 11-15 ultimately depend from a patentable base claim (5), Applicant respectfully submits that in addition to any independent bases for patentability, claims 6 and 11-15 are likewise patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

Applicant has amended claim 16 to more particularly include the feature wherein each configuration within the decompressed cache is identified by a unique off-chip address used to fetch that configuration. As provided above, neither the Greenbaum nor Singh references disclose or suggest such a feature. Accordingly, Applicant respectfully submits that rejection of claim 16 has been overcome. Thus, Applicant respectfully requests that the §103 rejection of claim 16, as amended, be withdrawn.

Insofar as claim 17, 21 and 22 depends from patentable base claim 16, as amended, or claim 20, Applicant respectfully submits that in addition to any independent bases for patentability, claims 17, 21 and 22 are patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103 rejection of claim 17, 21 and 22 be withdrawn.

§103(a) Rejection of Claim 7

In **paragraphs 15 and 16** of the Action, claim 7 was rejected as being unpatentable over the Greenbaum reference in view of a patent issued to Silberman et al. (USP 6,088,763), pursuant to 35 USC §103(a). In response, Applicant respectfully traverses the rejection of claim 7.

Applicant notes that the Silberman reference is not cited as curing and does not, in fact, cure the limitations in the Greenbaum reference vis-à-vis rejected claim 5, as provided above. Accordingly, Applicant respectfully submits that claim 5 is patentable over the combination of such references for at least the distinguishing arguments provided above.

Insofar as claim 7 ultimately depends from a patentable base claim (5), Applicant respectfully submits that in addition to any independent bases for patentability, claim 7 is likewise patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of claim 7 be withdrawn.

§103 Rejection of Claims 18 and 19

In **paragraphs 17-19** of the Action, claims 18 and 19 were rejected as being unpatentable over the Greenbaum and Singh references as applied to claims 5-6, 11-17 and 20-22 above, in

further view of a patent issued to Yoshida (USP 5,951,708), under 35 USC §103(a). In response, Applicant traverses the rejection of such claims.

Applicant notes that the Yoshida reference is not cited as curing and does not, in fact, cure the limitations in the Greenbaum and/or Singh references vis-à-vis rejected claims 5, 16 and 20, as provided above. Accordingly, Applicant respectfully submits that claims 5, 16 and 20 remain patentable over the combination of such references for at least the distinguishing arguments provided above.

Insofar as claims 18 and 19 ultimately depend from a patentable base claim 16, as amended, Applicant respectfully submits that in addition to any independent bases for patentability, claims 18 and 19 are likewise patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.


CONCLUSION

Applicant respectfully submits that pending claims 5-7, 11-13 and 15-22 are in condition for allowance, and earnestly awaits notice thereof. Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #50-0221. If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned is respectfully solicited.

Respectfully submitted,
Christopher E. Phillips, et al.

Dated: May 12, 2004

by:



Michael A. Proksch
Reg. No. 43,021
Attorney for Assignee

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., 7th Floor
Los Angeles, CA 90025
Telephone: (503) 264-3059